

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Stewart Harris et al.
Application No. : 09/755,591 Confirmation No. : 3838
Filed : January 5, 2001
For : SYSTEMS AND METHODS FOR MONITORING
CREDIT OF TRADING COUNTERPARTIES
Group Art Unit : 3693
Examiner : Thu Thao Havan

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR COMPLETION OF OFFICE ACTION
PURSUANT TO MPEP § 710.06

Sir:

Pursuant to MPEP § 710.06, Applicants call to the attention of the Examiner errors in the Office Action of October 17, 2007, and request (a) that the Office Action be reissued in corrected and completed form, and (b) that the period for reply be reset to at least one month from the date of the reissued Office Action.

Specifically, MPEP § 710.06 states in part:

710.06 Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or **an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant.** ... The new period for reply must be at least 1 month and would run from the date the error is corrected.

(emphasis added); MPEP § 710.06.

The Office Action contains the following errors that affect Applicants' ability to reply to the Action. Applicants request that the Examiner provide a corrected Office Action that addresses all of the following issues:

A. REJECTION OF CLAIMS 1-4, 9-10, 12-15, 20-21, 24, 27-29, 31-47, 51, and 53-61 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

1. Applicants are unable to respond to the rejection of claims **1-4, 9-10, 12-15, 20-21, 24, 27-29, 31-47, 51, and 53-61** under 35 U.S.C. § 112, first paragraph, because contrary to the MPEP, the Examiner failed to:

- identify the claim limitation(s) at issue, and
- provide any evidence or reasoning to support the rejection.

2. Specifically, in rejecting the claims the Examiner merely asserted that the claims

are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. However, the MPEP states that when rejecting claims under 35 U.S.C. § 112, first paragraph, as failing to completely with the written description requirement, the Examiner must also **(a)** identify the claim limitation(s) at issue, and **(b)** provide evidence or reasoning to support the rejection. Specifically, MPEP § 2163.04(I) states in part:

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion.... These findings should:

(A) **Identify the claim limitation at issue;** and

(B) **Establish a prima facie case by providing reasons why** a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

(emphasis added); MPEP § 2163.04(I).

4. Similarly, in rejecting the claims the Examiner used, in part, form paragraph 7.31.01 as set forth in MPEP § 706.03(c). However, the Examiner failed to also provide the information related to “bracket 2” as set forth in this form paragraph. Specifically, with respect to form paragraph 7.31.01, the MPEP states in part:

¶ 7.31.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Description Requirement, Including New Matter Situations

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. [2]

Examiner Note...

2. **In bracket 2, identify** (by suitable reference to page and line numbers and/or drawing figures) **the subject matter not properly described in the application as filed, and provide an explanation of your position.** The explanation should include any questions the examiner asked which were not satisfactorily resolved and consequently raise doubt as to possession of the claimed invention at the time of filing.

(emphasis added); MPEP § 706.03(c).

B. REJECTION OF CLAIMS 57-61 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

1. Applicants are unable to respond to the rejection of claims **57-58** and **60-61** under 35 U.S.C. § 112, first paragraph, regarding the limitation “*net position*” because these claims do not recite this limitation.
2. Nonetheless, contrary to the Examiner’s assertions, “*net position*” is disclosed in the originally filed Specification. For example, see Specification page 4, lines 10-25 and Specification page 9, line 30 to page 10, line 10.

C. ONE MONTH PERIOD FOR REPLY TO OFFICE ACTION

1. Applicants are unclear as to why the Examiner set a one month shortened statutory period for reply to the Office Action. In particular, MPEP § 710.02(b) indicates that with respect to an office action on the merits, an applicant should be given a three month shortened statutory period for reply. Applicants respectfully request that if the Examiner maintains the rejection of the claims and reissues the Office Action, that the Examiner set the period for reply to three months.

D. CONCLUSION

Applicants request a correction and completion of the Office Action, and a resetting of the time for reply. If no rejection can be framed within the requirements of the MPEP and the above noted issues, Applicants request that the application be passed to issue in due course. The Examiner is urged to telephone Applicants' undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicants petition for that extension of time required to make this reply timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938.

Respectfully submitted,

November 16, 2007
Date

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